

REMARKS

STATUS OF CLAIMS

Claims 1-14 have been pending.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Michel et al., U.S. Patent No. 5,625,690 (hereinafter "Michel"), in view of Lampson et al., U.S. Patent Application Publication No. 2003/0194094 (hereinafter "Lampson"), and in further view of Chiles et al., U.S. Patent No. 6,167,567 (hereinafter "Chiles").

In accordance with the foregoing, the pending claims remain for reconsideration, which is respectfully requested.

No new matter has been added.

The Examiner's rejections are respectfully traversed.

WITHDRAWAL OF THE FINALITY OF THE OFFICE ACTION:

Independent claims 1-7, 9-11 and 13-14 are allegedly unpatentable over Michel, Lampson and Chiles.

The Office Action, at page 3, lines 3-5, asserts: "... Chiles discloses user agreed updates and a new license file installation. Therefore, a combination of these references teaches the present invention as claimed." Further, the Office Action, at page 3, lines 22-25, asserts: "Michel and Lampson do not disclose user at the terminal device agrees to update the license file and a new license file installation. However, Chiles discloses this feature (col. 14, lines 62-col. 19, lines 19; also see Fig. 5A-5D)."

Appellants respectfully submit that the rejection is deficient because the rejection fails to meet the requirements of 37 C.F.R. §1.104(c)(2), which recites:

(c) Rejection of claims.

...

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.**

(emphasis added). That is, the Final Office Action failed to meet the requirements of 37 C.F.R. §1.104(c)(2) because the particular part relied on was not designated as nearly as practicable. In other words, the Applicants respectfully submit that the Office Action's citation to 6 columns and four figures of Chiles fails to designate the particular part of the reference as nearly as practicably, namely, the term "license" is not found on Chiles.

Applicants found no evidence that Chiles at column 14, line 62 to column 19, lines 19 and Fig. 5A-5D discloses the claimed "when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed," as recited, for example, in claim 1. For example, Chiles at column 14, lines 59-61 recites: "FIGS. 5A-5D collectively depict a detailed flowchart of software updating application 500; the correct alignment of these drawing sheets is shown in FIG. 5." That is, FIGS. 5A to 5D of Chiles discuss a software updating application. Accordingly, Applicants respectfully submit that the rejection fails to meet the requirements to clearly explain the pertinence of each reference, because it is unclear how a software updating application relates to, or disclose (either expressly or implicitly), the claimed "when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed," as recited, for example, in claim 1.

Furthermore, MPEP § 2142 recites, in part:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that **"rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."** *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). <

(emphasis added). The Office Action, at page 4 asserts: "it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to modify the disclosure of

Michel to include the disclosure of Lampson and Chiles.” However, the Office Action fails to provide any evidence that the disclosure of Michel, Lampson and Chiles, if combined, would disclose or render obvious the claimed embodiments. Accordingly, Appellants respectfully submit that the Final Office Action failed meet the burden for establishing an obviousness rejection, because the Final Office Action merely made the conclusory statement that “Chiles discloses this feature (col. 14, line 62-col. 19, lines 19; also see Fig. 5A-5D)” without providing any basis for the rejection.

Furthermore, the Applicants respectfully submit that the Office Action fails to provide any evidence that one skilled in the art would modify Chiles’ software updating application to include the claimed “when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed,” as recited, for example, in claim 1.

The Applicants respectfully request withdrawal of the finality of the Office Action, and issuance of a new non-final Office Action which meets the requirements of 37 C.F.R. §1.104(c)(2) by providing specific citations while articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

(a) no claim amendments are presented, and, thus, the Response should not entail any further search by the Examiner because it is believed the remarks clarify the patentably distinguishing features of the claimed invention without raising new issues, and the remarks apply the disclosures of Michel, Lampson and Chiles specifically to the language of the claims, thus warranting consideration of the remarks and withdrawal of the rejection of claims and/or withdrawal of the finality of the Office Action.

35 U.S.C. §103(a) REJECTION:

Independent claims 1-7, 9-11 and 13-14 are allegedly unpatentable over Michel, Lampson and Chiles.

As noted above, the Office Action, at page 3, lines 22-25, asserts: “Michel and Lampson do not disclose user at the terminal device agrees to update the license file and a new license

file installation. However, Chiles discloses this feature (col. 14, lines 62-col. 19, lines 19; also see Fig. 5A-5D)."

Applicants respectfully disagree with the assertion because Lampson's "certificate" merely stores information on an application. See, for example, Lampson, at paragraph 86, lines 3-11, which recites:

In one embodiment, the rights manager certificate 210 extends a standard digital certificate, which includes such items as date of publication and name of the application, by adding a list of services, or properties, provided by the application, i.e., content type handled, version of the application, whether it saves content to disk, etc.

Further, Applicants respectfully disagree with the assertion because the term "license" is not found in Chiles, and Chiles at column 14, lines 59-61 recites: "FIGS. 5A-5D collectively depict a detailed flowchart of software updating application 500; the correct alignment of these drawing sheets is shown in FIG. 5." That is, FIGS. 5A to 5D of Chiles discuss a software updating application. Furthermore, Chiles, at column 14, lines 62-67 recites:

Upon occurrence of a user-configured date for a product update or a user-initiated update for that product, e.g., software product i, application 500 executes. Within this application, execution first proceeds to block 503 which reads a URL for an FTP update site for this product and then attempts to establish an FTP connection to this site.

In other words, Chiles discusses that a user can set a date or manually causes execution of application 500 which attempts to connect to an FTP site to update software.

Accordingly, Applicants respectfully submit that Chiles fails to disclose the claimed "when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed," as recited in claim 1, because Chiles merely discusses connecting to an FTP site to update software.

Applicants respectfully submit that a *prima facie* case of obviousness cannot be based upon Michel, Lampson and Chiles, because there is no evidence that one skilled in the art would combine Michel's pay per use system, Lampson's rights management certificate stored at the application (see, for example, Figure 2) and Chiles FTP software updating site, and modify the combination to include the claimed "license file in the terminal device" and "when the license file

is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed," as recited in claim 1, and seen the benefit of enabling a user, at the terminal, to install a new license to access content.

The Office Action does not support the rationale (i.e., "the motivation for such a combination is within the general knowledge available to one of ordinary skill in the art"), at page 4 of the Office Action, to find obviousness. For example, the Office Action provided no evidence that one skilled in the art would have modified the combined Michel's pay per use system, Lampson's rights management certificate stored at the application (see, for example, Figure 2) and Chiles FTP software updating site, and modify the combination to include the claimed "license file in the terminal device" and "when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed," as recited in claim 1.

Applicants respectfully submit that independent claims 2-7, 9-11 and 13-14 patentably distinguish over the cited references for similar reasons as claim 1.

Dependent claims recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence from the independent claims. Withdrawal of the rejection of pending claims, and allowance of pending claims is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.


Serial No. 09/767,721

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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